

REMARKS

In the Office Action, the Examiner rejected claims 26-29 and 36¹ under 35 U.S.C. § 101; and rejected claims 20-28 and 30-36² under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0228809 by Asano et al. ("Asano"); and rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Asano in view of U.S. Patent Application Publication No. 2004/0003139 by Cottrille et al. ("Cottrille").

By this amendment, Applicants propose to amend independent claims 20, 24, 26, 30, 34, and 36. Upon entry of this amendment, claims 20-36 would remain pending and under examination.

Applicants respectfully traverse the rejection of claims 26-29 and 36 under 35 U.S.C. § 101. The Examiner alleges that claims 26-29 and 36 are "directed to neither a 'process' nor an 'apparatus,' but rather embrace and overlap two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as to set requirements for the statutory classes of invention in the alternative only," citing *Ex Parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) and M.P.E.P. § 2173.05(p).

Applicants respectfully submit that claims 26-29 and 36 fully comply with § 101. The claims at issue in *Ex Parte Lyell* required "an automatic transmission tool . . . and method for using same comprising," such that the claims "purport to claim both an apparatus and method of using the apparatus in a single claim." Claim 26, in contrast,

¹ Although the heading on page 2 of the Office Action indicates claims 20-29 and 36 are rejected under § 101, the rejection only addresses claims 26-29 and 36. Because claim 20 expressly requires an "apparatus," Applicants assume the heading on page 2 contains a typographical error and that the Examiner intended to reject claims 26-29 and 36 under § 101.

² Although the heading on page 5 of the Office Action indicates claims 20-36 are rejected under § 102, the rejection only addresses claims 20-28 and 30-36. A separate rejection under § 103(a) is provided for claim 29. Applicants therefore assume the heading on page 5 contains a typographical error.

only recites a single statutory class, a product, as a computer-readable medium. Execution of steps by a computer-readable medium, as required by claim 26, distinguishes from claiming both a computer-readable medium and a method for using the computer-readable medium. Indeed, as M.P.E.P. § 2106.01 instructs: "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and **is thus statutory**." (emphasis added). And, claims that recite "a computer program [] used in a computerized process where the computer executes the instructions set forth in the computer program" are statutory. M.P.E.P. § 2106.01. Further, "When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." *Id.*

Accordingly, claim 26, which recites a physical structure—a "computer-readable medium," is properly treated as a product claim, is used by a computer to execute instructions, and is statutory. Claims 27-29 and 36, although of different scope than claim 26, meet the requirements of § 101 for at least the same reasons as claim 26. Applicants therefore respectfully request the Examiner to withdraw the rejection of claims 26-29 and 36 under § 101.

Applicants respectfully traverse the rejection of claims 20-28 and 30-36 under 35 U.S.C. § 102(e) as being anticipated by Asano. To properly establish that Asano anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or

under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim."

M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 20, as proposed to be amended, calls for an information processing apparatus for granting access to content including "a storage unit for storing an attribute information list, the attribute information list identifying a type of information processing apparatus and identifying a function of the information processing apparatus; and an interpretation module for determining, before acquiring a content key for decrypting the content, whether the type and the function included in the attribute information list matches data contained in a property selection list distributed with the content, wherein: the property selection list includes a process code, the process code defining a comparison for the information processing apparatus to perform between the attribute information list and the property selection list, the comparison including: when the type and the function match the data, the information processing apparatus grants access to the content, and when the type and the function do not match the data, the information processing apparatus denies access to the content" (emphasis added). Asano does not teach or suggest the claimed "property selection list" or "interpretation module."

Asano discloses an encryption technique "in which an enabling key block (EKB) including encrypted key data which can be decrypted by one or more selected category trees is produced thereby making it possible for devices belonging to any one of the selected category trees to use the enabling key block (EKB), and an EKB type definition list, indicating which EKB type can be processed or decrypted by which category tree."

Asano, paragraph 0015. Applicants' Specification acknowledges that a key "applied to the decrypting of the encrypted content key 53 is acquired by performing a decrypting process on an enabling block key (EKB) based on a device node key (DNK)," but states "[t]he above-mentioned device node key (DNK) and the enabling key block (EKB) are not essential in the arrangement of the present invention." Applicants' Specification at p. 21, line 22-p. 22, line 15.

Applicants therefore acknowledge that the disclosed invention can work with systems such as Asano, but is not required to do so. Instead, Applicants' claims are fundamentally different than the disclosure of Asano. Applicants' claims compare an "attribute information list identifying a type of information processing apparatus and identifying a function of the information processing apparatus," which may be stored by a device for playing content, with "data contained in a property selection list distributed with the content." By comparing the type and capabilities of a device with data in a property selection list, an owner of content can create a license that only allows devices that meet criteria defined in the property selection to utilize the content. Asano does not teach or suggest an "interpretation module" for performing such a comparison, as recited by claim 20.

Moreover, as required by claim 20, the "interpretation module . . . determin[es], before acquiring a content key for decrypting the content, whether the type and the function included in the attribute information list matches data contained in a property selection list distributed with the content" (emphasis added). Even assuming Asano performed a comparison of type and function, which Applicants do not concede, Asano does not perform any comparison between an "attribute information list" and a "property

selection list distributed with the content" before acquiring a content key, as required by claim 20.

Moreover, claim 20 requires that the "property selection list includes a process code, the process code defining a comparison for the information processing apparatus to perform between the attribute information list and the property selection list" (emphasis added). Therefore, a content provider may transmit a process code that identifies the circumstances in which an information processing apparatus may be granted or denied access to the content. Asano does not teach or suggest the claimed "process code."

Accordingly, Asano cannot anticipate claim 20. Independent claims 26, 30, and 36, although of different scope than claim 20, patentably distinguish from Asano for at least the same reasons as claim 20. Claims 21-25, 27, 28, and 31-35 depend from independent claims 20, 26, or 30 and include all of the elements recited therein. Applicants therefore respectfully request the Examiner to withdraw the rejection of claims 20-28 and 30-36 under § 102(e) as being anticipated by Asano.

Applicants respectfully traverse the rejection of claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Asano in view of Cottrille. A *prima facie* case of obviousness has not been established at least because the differences between the prior art and Applicants' claims are such that it would not have been obvious for one of ordinary skill in the art at the time of the invention to modify the prior art to arrive at Applicants' claimed invention.

Claim 29 depends from independent claim 26 and therefore includes all of the elements recited therein. Cottrille fails to teach or suggest a "property selection list,"

attribute module for performing a comparison “before acquiring a content key,” and “process code,” as recited by claim 26 and required by claim 29, nor does the Examiner rely on Cottrille for such a teaching.

Because Asano and Cottrille, taken individually or in combination, fail to teach or suggest each and every element required by claim 29, no *prima facie* case of obviousness has been established for claim 29. Applicants therefore respectfully request the Examiner to reconsider and withdraw the rejection of claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Asano in view of Cottrille.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 20-36 in condition for allowance. Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. Entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance. And, entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing, Applicants request entry of this Amendment and the timely allowance of the pending claims.

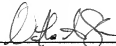
Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 31, 2008

By: _____



Nathan A. Sloan
Reg. No. 56,249
404.653.6464